

REMARKS

Claims 80–93 are pending in this application, and have all been rejected under 35 U.S.C. § 103 as being unpatentable over US Pat. No. 6,246,996 to Stein et al. ("Stein.") It is submitted that claims 80–93 are allowable over the cited art of record for the reasons discussed below.

The Office Action asserts that "besides old and well known claimed limitations, the only "arguable" limitation in independent claims describing : sending a message to a server, that server would forward said message comprising a computer address, then accessing that address. This limitation has been done in computer processing because instead of putting a URL (a computer address) in an e-mail, a user can type that address in "GO TO" block on Netscape website to access that same address OR the same method has been INHERENTLY DONE by any computer server."

It is asserted that the Office Action has improperly paraphrased the claims of the application. For example, the claims do not recite the supposedly only "arguable" limitation of sending a message to a server, that server would forward said message comprising a computer address, then accessing that address. Further, it is not understood how "a user can type that address in "GO TO" block on Netscape website to access that same address" is relevant to the present claims, because the present claims do not recite anything about a user typing an address in GO TO block on Netscape to access or website. Further, the Office Action seems to assert that the method is inherently done on any computer. This inherency assertion is challenged, and it is requested that the Examiner provide documentary evidence of such.

The Office Action points to elements 12 (Internet), 20 (information buyer) and 28 (information seller) of Stein and asserts that "Above limitations are merely structural connections between 2 parties, and a middleman (a server) that teach the claimed steps of claim 80. This is old and well known interactions in Internet for communication purposes between different parties." The Office Action then asserts that it would have been obvious to one of ordinary skill to practice Stein's patent and that the subject matter of the claim is old and well known.

However, the Office Action fails to assert which steps of claim 80 are supposedly well known. The Office Action fails to point out where any of these steps are disclosed in Stein. Is the Examiner taking official notice that one or more of the steps are well known? If so, such official notice is traversed and references in support of any steps asserted to be well known are requested.

The Office Action also asserts that

Claim 80 recites:

80. A method for conducting electronic transactions over a network, comprising:
at a merchant computer:

 sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server; and

at the consumer information server:

 receiving, from the consumer computer, a connection request based on the link,

 sending, to the consumer computer, a request for registration information,

 receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, and

storing the registration information.

It is respectfully submitted that Stein does not disclose or suggest at least the following recited in claim 80: at a merchant computer: sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server; at the consumer information server: receiving, from the consumer computer, a connection request based on the link, sending, to the consumer computer, a request for registration information, and receiving, from the consumer computer, registration information in response to the request, the registration information including a

consumer identification number. The Office Action has failed to point out where any of these steps are disclosed, and thus has not established a prima facie case of obviousness.

In contrast to the claimed invention, Stein discloses a payment system for transferring funds to a second user from the account of a first user who purchases from the second user an "information product deliverable over the Internet." Stein 2:16-20. The payment system has a front end computer and a back end computer coupled via a private network. Stein 4:23-26. The front end executes programs for interacting with users. Stein 4:59-64. The back end contains a full copy of user account information, Stein 5:55-57 and 6:8-10, and interacts with a settlement system. Stein 9:58-60. This "isolates the buyer-seller activity which occurs on the Internet from the financial and credit activity which occurs off the Internet." Stein 9:60-63.

Stein discloses that the buyer sends a message containing the buyer's account number ("cardnumber") to the seller, who then sends an inquiry to the payment system to determine if the buyer's account can be charged the value of the transaction. Stein 6:57-67 and 7: 5-10. The seller sends the information product to the user and a funds "transfer-request message" to the payment system to have the payment system transfer funds from the buyer's account to the seller's account. Stein 7:44-47. The payment system asks the buyer to authorize the transfer, Stein 7:59-62, and the buyer sends a "transfer-response" message to the payment system. Stein 8:20-23. If the buyer grants permission for the transfer, then the payment system sends a "transfer-result" message to the seller, Stein 8:46-49, and settles the transaction by transferring the funds. See Stein 9:55 et. seq.

Stein also discloses a "cardholder application" process that "occurs when an Internet user 14 wishes to establish a cardholder account 100." Stein 12:36-37.

None of the foregoing discloses or suggests the claimed invention. Stein does not disclose or suggest sending a request for registration information to a consumer computer whose user has selected a link in an received e-mail message, nor receiving registration information that includes a consumer identification number in response. On the contrary, as described above, Stein describes a payment system that already stores consumer registration

information. "In order to use the payment system 10 for transactions, the information buyer 20 and the information seller 28 both need to have subscriber or cardholder accounts with the payment system 10." Stein 5:12-15.

Stein neither discloses or suggests that the user receives an e-mail message containing a link that, if selected by the user, will prompt a request for registration information. Rather, Stein discloses that only that user send an "application-request message 227 over the Internet 12 to the payment system" to obtain a form through which the user can provide registration information. Stein is completely silent as to the mechanism by which such an "application-request message" is prompted or generated. Indeed, according to Stein, the user can send the "application-request message" completely on its own, without any prompting at all. Further, Stein does not disclose or suggest associating such a message with an electronic transaction. On the contrary, Stein discloses that "A cardholder application transaction occurs when Internet user 14 wishes to establish a cardholder account 100." Stein 12:37-39. In other words, the connection request that prompts the sending of a request for registration need not be associated with a transaction at all, but can be triggered anytime the user "wishes to establish a cardholder account." Id.

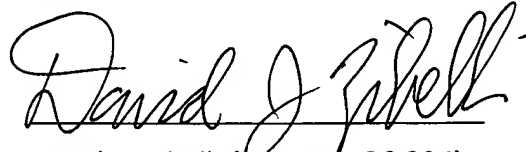
CONCLUSION

For at least the foregoing reasons, the Applicant respectfully submits that new claims 80-93 are allowable over the prior art of record. Accordingly, a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fees which may be necessary for consideration of this Response to Kenyon & Kenyon's Deposit Account No. 11-0600. A copy of this sheet is enclosed for this purpose.

Respectfully submitted,

KENYON & KENYON

A handwritten signature in cursive script, reading "David J. Zibelli", written over a horizontal line.

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